

ibuprofen, suprofen, ketoprofen, (S)-(+)-pranoprofen, or carprofen.

33. (Twice Amended) The method of claim 31 wherein said arylpropionic acid is ibuprofen, suprofen, ketoprofen, (S)-(+)-pranoprofen or carprofen.

### REMARKS

This responds to the Office Action mailed on January 30, 2001, in connection with the above-identified patent application. Claims 1, 2, 5-23, 25-31, and 33-39 are pending. Claims 5, 23, and 33 haven been amended to recite particularly preferred embodiments.

Claims 7, 10, 21, 31, 35, and 36 stand rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement. In addition, Claims 1, 2, 5-21, 23, 25, 27-31, and 33-39 stand rejected under 35 U.S.C. §112, first paragraph, for alleged lack of enablement with respect to arylpropionic acids other than ibuprofen, suprofen, pranoprofen, carprofen, and ketoprofen, and proteins other than serum albumin. Applicants respectfully request reconsideration of these rejections, as nothing in the Office Action establishes that the Applicants are not entitled to the full scope of the claims.

It is well established that the first paragraph of Section 112 of the patent statute requires only objective enablement of the invention. How the teaching is set forth, either by the use of specific examples or broad terminology, is of no importance. *In re Marzocchi*, 169 USPQ 367 (C.C.P.A. 1971). Accordingly, when rejecting a claim under the enablement requirement, it is the PTO who bears the initial burden of setting forth a reasonable explanation as to why the scope of protection is not adequately enabled. *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993). To properly assert a rejection on the grounds that the disclosure is not enabling, the Office Action must provide evidence or sound technical reasoning substantiating its position. Without a reason to doubt the truth of the statements made in the patent application, the application *must be considered enabling*. *Id.* The following statement from *In re Armbruster*, 512 F.2d 676, 677 (C.C.P.A. 1975) is noteworthy: